

as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Form Paragraph 7.44 may be used where originally claimed subject matter lacks proper antecedent basis in the specification. See MPEP § 608.01(o).

2163.07 Amendments to Application Which Are Supported in the Original Description [R-1]

Amendments to an application which are supported in the original description are NOT new matter.

I. REPHRASING

Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000). In *Schering*, the original disclosure drawn to recombinant DNA molecules utilized the term "leukocyte interferon." Shortly after the filing date, a scientific committee abolished the term in favor of "IFN-(a)," since the latter term more specifically identified a particular polypeptide and since the committee found that leukocytes also produced other types of interferon. The court held that the subsequent amendment to the specification and claims substituting the term "IFN-(a)" for "leukocyte interferon" merely renamed the invention and did not constitute new matter. The claims were limited to cover only the interferon subtype coded for by the inventor's original deposits.

II. OBVIOUS ERRORS

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Where a * foreign priority document under 35 U.S.C. 119 is of record in the >U.S.< application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending >U.S.< application. *Ex parte Bondiou*, 132 USPQ 356 (Bd. App. 1961). This prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. This prohibition does not apply ** where the *>U.S.< application explicitly incorporates **>the foreign priority< document by reference.

>Where a U.S. application as originally filed was in a non-English language and an English translation thereof was subsequently submitted pursuant to 37 CFR 1.52(d), if there is an error in the English translation, applicant may rely on the disclosure of the originally filed non-English language U.S. application to support correction of an error in the English translation document.<

2163.07(a) Inherent Function, Theory, or Advantage

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

2163.07(b) Incorporation by Reference [R-1]

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. See MPEP § 608.01(p) for Office policy regarding incorporation by reference. >See MPEP § 2181 for the impact of incorporation by reference on the determination of whether applicant has complied with the requirements of 35 U.S.C. 112, second paragraph when 35 U.S.C. 112, sixth paragraph is invoked.<

2164 The Enablement Requirement

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent.

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. A patent claim is invalid if it is not supported by an enabling disclosure.

The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the descrip-

tion requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) (“the purpose of the ‘written description’ requirement is broader than to merely explain how to ‘make and use’”). See also MPEP § 2161. Therefore, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria.

Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation. When claimed subject matter is only presented in the claims and not in the specification portion of the application, the specification should be objected to for lacking the requisite support for the claimed subject matter using Form Paragraph 7.44. See MPEP § 2163.06. This is an objection to the specification only and enablement issues should be treated separately.

2164.01 Test of Enablement

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term “undue experimentation,” it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the

extension." Having relied so heavily on the Abraham theoretical formula, Carter was limited to it in his claims. Further, the amendments "were not permissible" under *Schriber-Schroth*.

"It follows that Claims 15 and 16, so far as they claim antennae of wire lengths intermediate of multiples of half wave lengths, are invalid. So far as the patent discloses and claims invention of a structure made in conformity to the Abraham formula, petitioner's structures do not infringe, for none of them conforms to the Abraham formula."²¹

The Court's reading of the Carter specification seems niggardly to the point of unfairness.²⁰ It does not address the apparently clear statement that the empirical formula Carter derived from the Abraham theoretical formula was "found accurate for all practical purposes" for intermediate wire lengths.

[2]—Conforming and Clarifying Amendments

An amendment to a specification does not violate the new matter rule if it merely "clarifies or completes" the original disclosure.¹ Further, the specification and drawings may be amended to conform to each other.²

²¹ 306 U.S. at 101.

²⁰ *Mackay Radio* dates from a period of marked Supreme Court hostility toward patents. See § 5.02[3] *supra*.

§ 11.04[2]

¹ E.g., *Hobbs v. Beach*, 180 U.S. 383 (1901), discussed at § 11.04[1][e] *supra*; *Austin v. Marco Dental Prods., Inc.*, 560 F.2d 966, 972, 195 USPQ 529, 534 (9th Cir. 1977), *cert. denied*, 435 U.S. 918 (1978) ("The amendment in question did not constitute new matter but rather eliminated old matter, claims which Austin believed had been described too broadly and, therefore, relied on prior art."); *Rhone-Poulenc S.A. v. Dann*, 507 F.2d 261, 184 USPQ 196 (4th Cir. 1974), *cert. denied*, 422 U.S. 1009 (1975); *Triax Co. v. Hartman Metal Fabricators, Inc.*, 479 F.2d 951, 956-957, 178 USPQ 142, 146 (2d Cir. 1973), *cert. denied*, 414 U.S. 1113 (1973) ("simply clarifies or completes the prior disclosure"); *Tektronix, Inc. v. United States*, 445 F.2d 323, 326-27, 165 USPQ 392, 394 (Ct. Cl. 1971), *appeal after remand*, 575 F.2d 832, 198 USPQ 378 (Ct. Cl. 1978), *cert. denied*, 439 U.S. 1048 (1978) ("In essence, what the applicant did was amend the drawing and specification in response to queries by the patent examiner, and thereby simply made explicit a disclosure which was implicit in the application as filed."); *In re Wright*, 343 F.2d 761, 145 USPQ 182 (CCPA 1965); *Helms Prods. v. Lake Shore Mfg. Co.*, 227 F.2d 677, 679, 107 USPQ 313, 314 (7th Cir. 1955) ("Amendments to specifications for the purpose of clarity and definiteness are permissible.").

² *In re Heinle*, 342, F.2d 1001, 1007, 145 USPQ 131 (CCPA 1965); *Bloodhart v. Levemier*, 64 F.2d 367, 369, 17 USPQ 188 (CCPA 1933).

[a]—**Clarifications.** Court decisions state, in various ways, that specifications may be amended to “clarify” the original disclosure; thus: (1) “insertions by way of amendment in the description or drawing, or both, of a patent application do not invalidate the patent, if they are only in amplification and explanation of what was already reasonably indicated to be within the invention”;³ (2) “amendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions”;⁴ (3) “an amendment to an application is not ‘new matter’ within the Patent Act or Rules of the Patent Office unless it discloses ‘an invention, process or apparatus not theretofore described.’ . . . If the later-submitted material accused of being ‘new matter’ simply clarifies or completes the prior disclosure it cannot be treated as ‘new matter.’ . . . Moreover, the determination of the Patent Office to admit the later-submitted material, thereby signifying that the Patent Office does not consider it to be ‘new matter,’ is presumptively correct.”;⁵ (4) “the amendments to the specification merely render explicit what had been implicitly disclosed originally, and, while new language has certainly been added, we are not prone to view all new ‘language’ ipso facto as ‘new matter.’ ”⁶

Numerous decisions find amendments not new matter.⁷

³ *Michigan Carto Co. v. Sutherland Paper Co.*, 29 F.2d 179, 184 (6th Cir. 1928).

⁴ *Quigley v. Zimmerman*, 73 F.2d 499, 503, 23 USPQ 310 (CCPA 1934).

⁵ *Triax Co. v. Hartman Metal Fabricators, Inc.*, 479 F.2d 951, 956-957, 178 USPQ 142, 146 (2d Cir. 1973), *cert. denied*, 414 U.S. 1113 (1973).

⁶ *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965).

⁷ *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 24 USPQ2d 1401 (Fed. Cir. 1992), discussed at § 11.04[6] *infra*; *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 664, 231 USPQ 649, 653 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 933 (1987) (“[I]n examining [the patentee’s parent application], the examiner had invited [the applicant] to refer to published circuits and commercially available items that performed the function of [the applicant’s] boxes. Such added subject matter, to the extent that [it] is not ‘new matter’, does not deprive the [applicant’s subsequent continuation-in-part application] of the original filing date.”); *Procter & Gamble Mfg. Co. v. Refining Inc.*, 135 F.2d 900, 904, 57 USPQ 505 (4th Cir. 1943); *H.H. Robertson Co. v. Klauer Mfg. Co.*, 98 F.2d 150, 152-153, 38 USPQ 203 (8th Cir. 1938); *Novadel Process Corp. v. J.P. Meyer & Co.*, 35 F.2d 697, 3 USPQ 180 (2d Cir. 1929); *Genentech Inc. v. Wellcome Foundation Ltd.*, 798 F. Supp. 213, 24 USPQ2d 1782, 1785 (D. Del. 1992), *rev’d*, 29 F.3d 1555, 31 USPQ2d 1161 (Fed. Cir. 1994) (substantial evidence supported a jury’s verdict that the addition to plaintiff’s patent pertaining to “human” tissue plasminogen activator (t-PA) of a reference to a specific activity of “about 500,000 IU/mg” was not new matter; evidence

An amendment violates the rule if it adds matter “neither disclosed nor suggested” in the original specification, drawings and claims or cures a fundamental defect in the original disclosure.⁸

indicated that the limitation “was an inherent feature of the claimed t-PA”); *Northern Telecom Inc. v. Datapoint Corp.*, 9 USPQ2d 1577, 1594 (N.D. Tex. 1988) (“The amendments did only what they were represented to do, explain the state of the prior art.”); *Chemcast Corp. v. Arco Industries Corp.*, 5 USPQ2d 1225, 1236-1237 (E.D. Mich. 1987), *aff’d in part, rev’d, in part, vacated in part & remanded*, 854 F.2d 1328 (Fed. Cir. 1988)(unpublished) (original specification disclosed a “castable resinous material”; in response to a final rejection, the applicant introduced by amendment an example of such material—“for example, . . . polyvinyl chloride”; “The term polyvinyl chloride is new to the specification but that does not mean it is prohibited as ‘new matter.’ . . . The term is simply referred to in the amendment of the specification as an example of the type of vinyl that would be appropriate as a material in the grommet. As a more specific form of the generic vinyl term, it merely clarifies and makes more definite that which was already disclosed in the specification.”); *R.E. Phelon Company Inc. v. Wabash Inc.*, 640 F. Supp. 1383, 1 USPQ2d 1680 (N.D. Ind. 1986), *aff’d in part & vacated in part*, 824 F.2d 977 (Fed. Cir. 1987) (unpublished); *O’Hara Manufacturing Ltd. v. Eli Lilly & Co.*, 231 USPQ 753, 761 (N.D. Ill. 1986) (“a mere change in descriptive terminology does not amount to the addition of ‘new matter’”); *Thermo Tim, Inc. v. Mobil Oil Corp.*, 194 USPQ 450, 454 (W.D.N.Y. 1977) (“Figure 8 was not new matter but was a schematic enlargement of a portion of Figure 4.”); *Wayne-Gossard Corp. v. Sondra, Inc.*, 434 F. Supp. 1340, 1355, 195 USPQ 777, 790 (E.D. Pa. 1977), *aff’d*, 579 F.2d 41, 200 USPQ 11 (3d Cir. 1978) (“New matter is new and substantive information which might change the invention. It is information also which would be more properly presented in a new patent application.”); *Hadco Prods., Inc. v. Lighting Corp.*, 312 F. Supp. 1173, 1182-1183, 165 USPQ 496 (E.D. Pa. 1970), *rev’d on other grounds*, 462 F.2d 1265, 174 USPQ 358 (3d Cir. 1972), *cert. denied*, 409 U.S. 1023 (1972); *Reeves Bros., Inc. v. U.S. Laminating Corp.* 282 F. Supp. 118, 130-131, 157 USPQ 235 (E.D. N.Y. 1968), *aff’d*, 417 F.2d 869, 163 USPQ 577 (2d Cir. 1969); *Lee v. Congress Beauty Equip. Co.*, 48 F. Supp. 827, 831, 56 USPQ 217 (D. Mass. 1943).

⁸ *Mackay Radio & Tel. Co. v. Radio Corp.*, 306 U.S. 86, 37 USPQ 471 (1939), discussed at § 11.04[1][h] *supra*; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 39 USPQ 235 (1938), discussed at § 11.04[1][g] *supra*; *Steward v. American Lava Co.*, 215 U.S. 161 (1909), discussed at § 11.04[1][f] *supra*; *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.*, 111 U.S. 490 (1884), discussed at § 11.04[1][c] *supra*; *Chicago & N.W. Ry. Co. v. Sayles*, 97 U.S. (7 Otto) 554 (1878), discussed at § 11.04[1][b] *supra*.

See also *Dresser Indus., Inc. v. United States*, 432 F.2d 787, 792-793, 166 USPQ 336, 340, 167 USPQ 473 (Ct. Cl. 1970) (materially changed definition of term; amendment “must be disregarded in construing the scope and meaning of the claims”); *In re Sackett*, 135 F.2d 227, 231-232, 57 USPQ 318 (CCPA 1943); *Quigley v. Zimmerman*, 73 F.2d 499, 23 USPQ 310 (CCPA 1934); *In re Spinasse*, 69 F.2d 109, 20 USPQ 308 (CCPA 1934); *In re Bloch*, 65 F.2d 268, 269, 18 USPQ 17 (CCPA 1933) (“as originally filed, the application did not disclose the necessary machinery

Drawing the line between permissible clarification and impermissible addition is a different task and one to be resolved in the context of the facts of the particular case. In *Harries v. Air King Prods. Co.* (1950),⁹ Judge Learned Hand, in one of his classic patent law opinions, confessed that “No doubt it is at times hard to say whether amendments are a ‘departure from or improper addition to the specifications’ or have ‘merely made explicit what was already implicit’ We have ourselves often recognized this embarrassment”¹⁰

In *Harries*, three patents concerning radio tubes were at issue. The claims required a tube that focused the electrons from the cathode into a “long stream” of relatively small cross sections and had a “critical distance” between the accelerating electrode and the anode. Judge Hand rejected the patentee’s argument that “the absolute length of the stream is not an element of the invention” “We hold that the original specifications were for long streams, regardless of the ratio of length to cross-section, because the ratio was a later and unauthorized interpolation into the application as originally filed.”¹¹

“In their original form the introduction to the specifications . . . did not once mention the ratio of the length of the electron stream to its cross-section. It began by declaring that electron streams might

by which these parts could be operated. . . . [A]ppellant’s amendment, showing an apparently new machine, is something more than an illustration of a mechanism, old in the art, by which appellant’s alleged invention could be operated.”); *Stearn v. Superior Distributing Co.*, 674 F.2d 539, 215 USPQ 1089 (6th Cir. 1982); *Lopulco Sys., Inc. v. Bonnot Co.*, 24 F.2d 510 (3d Cir. 1928); *In re Mraz*, 36 App. D.C. 435, 1911 C.D. 316 (D.C. Cir. 1911); *Twin Disc, Inc. v. United States*, 10 Cl. Ct. 713, 231 USPQ 417 (Cl. Ct. 1986); *Grayhill, Inc. v. AMF Inc.*, 203 USPQ 745, 773 (D. N.J. 1978) (“In original applications, all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.”); *All States Plastic Mfg. Co. v. Weckesser Co.*, 362 F. Supp. 94, 98, 179 USPQ 717, 720 (N.D. Ill. 1973) (“The voluntary insert by the applicant Eberhardt in the description of the invention, to define a locking pawl as being of ‘essentially rhombohedral configuration’ and the inclusion of such term in the amended claims without proper support in the application as originally filed, constitutes new matter”); *Butterfield v. Oculus Contact Lens Co.*, 332 F. Supp. 750, 758–59, 171 USPQ 527 (N.D. Ill. 1971); *In re Fox*, 761 O.G. 906, 1960 C.D. 28 (Bd. Pat. App. 1957).

⁹ 183 F.2d 158, 86 USPQ 57 (2d Cir. 1950).

¹⁰ 183 F.2d at 160, 86 USPQ at 59.

¹¹ 183 F.2d at 159, 86 USPQ at 58.